

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HITOSHI HAYAMA
and
HAYAMA WATANABE

Appeal No. 1999-0163
Application No. 08/745,698

ON BRIEF

Before KRASS, RUGGIERO, and DIXON, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 4 and 6-8, which are the only claims remaining in the application. Claims 1-3 and 5 have been canceled. An amendment after final rejection filed December 4, 1997, was approved for entry by the Examiner.

The disclosed invention relates to a tape printer for printing data onto a printing tape medium and which includes a display which permits messages to be displayed in two or more languages. The language selection process is automatically started when power is first supplied to the tape printer. Thereafter, the language selection process is activated by pressing an additional key during a power-up sequence. If no additional key is pressed during power-up, printer operation proceeds without performance of the language selection process.

Claim 4 is illustrative of the invention and reads as follows:

4. A tape printer for printing on a tape medium, comprising:

input means for entering data to be printed;

memory means for storing said data and system settings of said tape printer;

display means for displaying said data entered by said input means and information regarding said system settings;

language selection means for selecting a language to be used for displaying messages on said display means;

tape cartridge storage means for accommodating a tape cartridge including said tape medium;

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wherein said language selection means is
automatically
started at a time when power is first supplied to the tape
printer and is selectively initiated by a combined operation
of a power supply key with at least one of the keys arranged
on said input means.

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The Examiner relies on the following prior art:

Sloan et al. (Sloan) 5,146,067 Sep. 08,
1992

Takaaki et al. (Takaaki) EP 0 473 147 A2 Mar.
04, 1992
(published European Patent application)

Hewlett-Packard, Your Guide to Setting Up Your LaserJet III
Printer, pp. 1-3 (1990).

Claims 4 and 6-8 stand finally rejected under 35 U.S.C.
§ 103 as being unpatentable over Sloan in view of Takaaki and
Hewlett-Packard. In a separate rejection, claims 4 and 6-8
stand finally rejected under 35 U.S.C. § 103 as being
unpatentable over Takaaki in view of Hewlett-Packard.

Rather than reiterate the arguments of Appellants and the
Examiner, reference is made to the Brief (Paper No. 26) and
Answer (Paper No. 27) for the respective details.

OPINION

We have carefully considered the subject matter on
appeal, the rejections advanced by the Examiner and the
evidence
of obviousness relied upon by the Examiner as support for the
rejections. We have, likewise, reviewed and taken into
consideration, in reaching our decision, Appellants'

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arguments set forth in the Brief along with the Examiner's rationale in support of the rejections and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 4 and 6-8. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to

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arrive

at the claimed invention. Such reason must stem from some teaching, suggestion, or implication in the prior art as a whole

or knowledge generally available to one having ordinary skill in

the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825

(1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.,

776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert.

denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v.

Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed.

Cir. 1984). These showings by the Examiner are an essential

part of complying with the burden of presenting a prima facie

case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445,

24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

With respect to the Examiner's obviousness rejection of independent claims 4 and 7 based on the combination of Sloan, Takaaki, and Hewlett-Packard, Appellants assert the Examiner's

failure to establish a prima facie case of obviousness since all of the claim limitations are not taught or suggested by the applied prior art references. In particular, Appellants contend (Brief, pages 12 and 13) that the Hewlett-Packard publication, which the Examiner relies upon to address the claimed language selection initiation feature, does not automatically start a language selection sequence on initial printer power-up as required by the language of appealed claims 4 and 7.

After careful review of the Hewlett-Packard reference, we are in agreement with Appellants' position as stated in the Brief. Our interpretation of the Hewlett-Packard disclosure coincides with that of Appellant, i.e., the eight step sequence of multiple key stroke combinations described in the reference for initiating language selection is anything but automatic.

We take note of the fact that, at pages 29 and 30 of the Answer, the Examiner offers an alternative interpretation of the language of claims 4 and 7. In the Examiner's view, the claimed language selection operations can be interpreted as requiring only one of the two operating modes, i.e., either

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automatic initiation or selective initiation by keystroke combination. Under this interpretation, the Examiner suggests that the sequence illustrated in the Hewlett-Packard reference would meet the selective initiation operation.

We can find, however, no basis on the record for the Examiner interpreting the claims in this manner. It is apparent to us that the only reasonable interpretation of the language of the claims before us requires the existence of two language selection operating modes which are initiated dependent on particular conditions. This is reflected in the language of appealed claims 4 and 7 which specifically recite that language selection is automatically started at initial power-up and is selectively initiated by a particular keystroke combination, a combination of features not taught or suggested in Hewlett-Packard. It is also apparent from the Examiner's line of reasoning in the Answer that, since the Examiner has mistakenly interpreted the disclosure of Hewlett-Packard as disclosing an automatic language selection feature, the issue of the obviousness of the inclusion of such a feature has not been addressed.

Since all of the claim limitations are not taught or

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suggested by the applied prior art, it is our opinion that the Examiner has not established a prima facie case of obviousness with respect to independent claims 4 and 7. Accordingly, we do not sustain the Examiner's 35 U.S.C. § 103 rejection of independent claims 4 and 7, nor of claims 6 and 8 dependent thereon, based on the proposed combination of Sloan, Takaaki, and Hewlett-Packard.

Turning to a consideration of the Examiner's separate obviousness rejection of claims 4 and 6-8 based on the combination of Takaaki and Hewlett-Packard, we do not sustain this rejection as well. As the basis for this rejection, the Examiner, instead of relying on the language selection features of Sloan, relies on Takaaki's teachings of language selection in a tape printer environment. The Examiner, however, continues to rely on Hewlett-Packard as disclosing an automatic language selection feature provided at initial power-up, a feature which, from our earlier discussion, we found lacking in the disclosure of the reference.

In conclusion, we have not sustained either of the Examiner's 35 U.S.C. § 103 rejections of the claims on appeal. Therefore, the decision of the Examiner rejecting claims 4 and

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6-8 is reversed.

REVERSED

JOSEPH F. RUGGIERO)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
ERROL A. KRASS)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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JOSEPH L. DIXON)	
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JFR:hh

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